

REMARKS

Claims 1-13, 16 and 19-26 stand rejected under 35 USC §102(e) as being anticipated by Brobst et al., U.S. patent 6,061,700. Claims 14-15 and 17-18 stand rejected under 35 USC §103(a) as being unpatentable over Brobst et al. in view of Kelley et al., U.S. patent 6,320,671.

Claims 1, 22 and 25 have been amended to more clearly state the invention. Reconsideration and allowance of each of the pending claims 1-26, as amended, is respectfully requested.

Brobst et al., U.S. patent 6,061,700 discloses an apparatus and method for formatting a specified group of related web pages into a single web page that allows a user to define a number of selected pages and associated relation criteria for each selected page. A formatting mechanism collects the URLs for the selected pages and those related pages based on the relation criteria and stores the URLs in a URL container. The formatting mechanism further invokes each web page associated to the URLs contained in the URL container and generates a conglomerate page. The conglomerate web page may include data insert into or referenced in one or more of the selected pages. The conglomerate web page may then be printed using a standard browser print function.

Kelley et al., U.S. patent 6,320,671 discloses a method and system for printing web pages from an intra- or internet source with a client computer. The client computer is capable of accessing and viewing a web page from an intra- or internet source and has access to a program storage. The program storage device includes (i)

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an HTML source file containing a list of printable web pages and (ii) a program of instructions executable by the computer at a predetermined, modifiable time to print web pages from the intra- or internet source with the client computer. The program selects one or more of the printable web pages from the HTML source file, accesses the web pages selected from the HTML source file, and prints the accessed web pages. The printable web pages may be accessed on different levels of hierarchy in HTML files. The storage device also contains a plurality of different lists of printable web pages and a menu of each of the lists, whereby the method includes selecting from the menu a desired list and providing an HTML source file containing the desired list of printable web pages.

Reconsideration and allowance of the subject patent application including each of the claims 1-26, as amended, is requested. To anticipate under section 102, a prior art reference must disclose all the elements of the claimed invention or their equivalents functioning in essentially the same way. The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations in the claim are found in the reference, or 'fully met' by it."

As amended, each of the independent claims 1, 22, and 25 distinguish over Brobst et al., U.S. patent 6,061,700. The web page selection mechanism 540 of

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Brobst et al. is used to create a list of user selected and related web pages. Then web page storing mechanism 550 stores the list of selected and related web pages in a URL format and conglomeration mechanism 560 takes the selected URLs and formats them into a flattened web page. As amended, each of the independent claims 1, 22, and 25 recite that the print index is explicitly specified by a web based document originator.

This feature of the method, apparatus and computer program product for implementing web based document printing is not shown, nor suggest by Brobst et al.

Reconsideration and withdrawal of the rejection of the claims 1-13, 16 and 19-26 under 35 USC §102(e) as being anticipated by Brobst et al., U.S. patent 6,061,700 is respectfully requested.

35 USC §103(c) states: "Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Brobst et al., U.S. patent 6,061,700 and Kelley et al., U.S. patent 6,320,671 and the present invention were commonly owned at the time the present invention was made. Brobst et al., U.S. patent 6,061,700 and Kelley et al., U.S. patent 6,320,671 are disqualified as prior art pursuant to 35 USC §103(c) and can not be applied as a reference to the subject patent application under 35 USC §103.

Each of the independent claims 1, 22, and 25 distinguish over Brobst et

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al., U.S. patent 6,061,700 and are patentable.

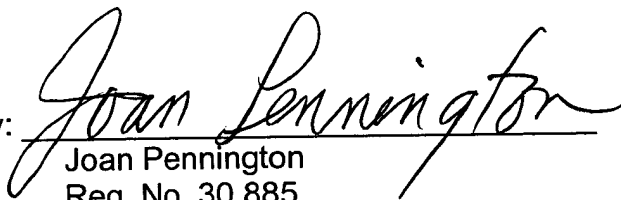
Dependent claims 2-21, 23-24, and 26 further define the invention of patentable independent claims 1, 22, and 25, and are likewise patentable.

Applicants have reviewed all the art of record, and respectfully submit that the claimed invention is patentable over all the art of record, including the references not relied upon by the Examiner for the rejection of the pending claims.

It is believed that the present application is now in condition for allowance and allowance of each of the pending claims 1-26 is respectfully requested. Prompt and favorable reconsideration is respectfully requested.

If the Examiner upon considering this amendment should find that a telephone interview would be helpful in expediting allowance of the present application, the Examiner is respectfully urged to call the applicants' attorney at the number listed below.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Please amend claims 1, 22, and 25 as follows:

1. (Amended) A method for implementing web based document printing comprising the steps of:

obtaining a print index; said print index explicitly specified by a web based document originator; [and]

identifying uniform resource locators (URLs) in said print index; and
sequentially printing said URLs in said print index.

22. (Amended) Apparatus for implementing web based document printing comprising:

a stored document print index, said print index explicitly specified by a web based document originator; said document print index including a list of user selected uniform resource locators (URLs) to be printed; and

a web based printing program utilizing said stored document print index for printing a document including said list of user selected uniform resource locators (URLs).

25. (Amended) A computer program product implementing web based document printing comprising:

a recording medium;

means, recorded on the recording medium, for storing a print index, said print index explicitly specified by a web based document originator; said print index including

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a list of user selected uniform resource locators (URLs) to be printed;

means, recorded on the recording medium, for obtaining said print index and for printing a document including said list of user selected uniform resource locators (URLs).